



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,386	04/12/2004	Bryan W. Vidler	STD 1222 PA/41213.596	2855
23368	7590	01/30/2008		
DINSMORE & SHOHL LLP ONE DAYTON CENTRE, ONE SOUTH MAIN STREET SUITE 1300 DAYTON, OH 45402-2023			EXAMINER. WILLIAMS, JAMILA O	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 01/30/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/822,386	VIDLER ET AL.	
	Examiner	Art Unit	
	Jamila Williams	3722	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Monica S. Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: the examiner maintains that the claimed data carrier is met by Blank. The data carrier of Blank discloses a release liner (18), health information label (14) having upper and lower surface and including areas for indicia (see figure 1 or 3 and indicia associated therewith), a pressure sensitive adhesive coating (20) on the lower surface of the label, securing the label to the release liner (18) and a label (32 - in that this label can be removed from label 14 and adhered to another object it satisfies the limitation of being a masking label as claimed) integral with the health information label (14) and a die cut in the release liner (18) defining a removable liner piece (40) beneath the label (32), the removable liner piece being removable from liner 18 with the health information label (14) and remaining thereon when the health information label (14) is applied to a surface (container in figure 3), the removable liner piece (40) permitting the removal of the masking label (which 32 is being considered to be the masking label) from the health information label so that the masking label can be applied over one or both of the first and second areas of indicia (looking at figure 5 and column 4 lines 38 -54 of Blank, in that the masking label 32 with liner piece 40 can be removed from the label 14 and adhered to another object, it is inherently capable of being applied to the first or second indicia areas of label 14 as claimed). As set forth in the final rejection the examiner takes the position that the sole difference between the Blank reference and the present invention is the arrangement and/or content of the printed matter. It has been held that when the claimed printed matter (first and second indicia or indicia areas) is not functionally related to the substrate (label) it will not distinguish the invention from the prior art in terms of patentability. In re Gullack, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate (label) may render the device more convenient by providing an individual with a specific type of information (identity of patient or health related information) does not alter the functional relationship. Mere support by the substrate (label) for the printed matter (indicia areas for identifying the patient or health related information) is not the kind of functional relationship necessary for patentability. As set forth above, the examiner asserts that the structure of Blank is the same and the difference lies in the content of the printed matter. Thus, there is no novel and unobvious functional relationship between the printed matter (indicia) and substrate (label) which is required for patentability.

In light of the above comments and those in the final rejection, the examiner respectfully disagrees with applicant's argument that the examiner never explains the deficiencies in the disclosure of Blank and never explains the modifications to meet the present invention. Blank meets the structures of the present invention and the sole difference is in the content of the printed matter.

Since the examiner finds that there is no functional relationship of the printed material to the substrate, altering the arrangement and/or content of the indicia (such that the first and second indicia areas provide patient identity and health related information and the label 32 provides masking indicia for example would have been obvious to one having ordinary skill in the art at the time the invention was made in light of the rationale of Gullack.

Regarding the argument towards claim 13, wherein applicant argues when the second label is separated from the first label, the second label is adapted to disassociate the identity of the patient from the health related information, the examiner maintains that Blank provides the label (14) having a removable label and liner portion (32,40) such that the removable label and liner portions (32,40) can be removed from the label (14) when attached to a container. In light of the Gullack rationale altering the arrangement/content of the indicia such that the identity of the patient is disassociated with the health related information on the label 14 would have been obvious.

Applicant's arguments towards In re Ngai are also noted but this case and its particulars were not relied on in the action and therefore no further comment is provided herein.

Applicant's arguments towards the sizing of the label are also noted. This argument is not supported by the holdings of either Gullack or Ngai. On the other hand, based on the skill level of one having ordinary skill in the relevant art, the examiner maintains that expedient sizing of a label would have been obvious if not clearly shown by the prior art.

The rejections on record of pending claims 1,2,4,6,13,15 are therefore maintained.

W 1/28/08

Monica S Carter
MONICA CARTER
SUPERVISORY PATENT EXAMINER